



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/612,598	07/07/2000	David A. Farber	PM 270531	7930

909 7590 12/05/2001

PILLSBURY WINTHROP LLP
1600 TYSONS BOULEVARD
MCLEAN, VA 22102

EXAMINER

GECKIL, MEHMET B

ART UNIT

PAPER NUMBER

2152

DATE MAILED: 12/05/2001

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/612,598

Applicant(s)

FARBER ET AL.

Examiner

Mehmet B. Geckil

Art Unit

2152

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 October 2001 and 20 November 2001.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 41, 45, 49, 50, 53-66 and 69 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 41 and 45 is/are allowed.
- 6) ☒ Claim(s) 49, 50, 53-66 and 69 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 26. 6) ☐ Other: _____

1. Claims 41, 45, 49-50, 53-66 and 69 are presented for examination.
2. The following is a quotation of the CFR § 1.71:
 - a) The specification must include a written description of the invention or discovery and of the manner and process of making and using the same, and is required to be in such full, clear, concise, and exact terms as to enable any person skilled in the art or science to which the invention or discovery appertains, or with which it is most nearly connected, to make and use the same.

The specification is objected to under CFR § 1.71, as failing to provide an adequate written description of the invention and failing to adequately teach how to make and use the invention, i.e. failing to provide an enabling disclosure.

Present claims were copied from the Patent No: 6,108,703 ("703" patent from herein on) in order to provoke an interference. Applicant in the response amended claims which recited the first first level and second level name servers language from the claims thus acknowledging that their architecture was different and did not support the copied claims. However, in the response applicant kept some of the broad method claims. These method claims were drafted to operate on the copied architecture, i.e. with the first level and second level name servers and applicant's architecture is different and thus enablement problem still exists with respect to these method claims. Examiner will summarily explain the two architectures in order to show how they operate differently. Applicant's system is the one having a reflector as described in the specification. The reflector includes some scripts to intercept the client request for a resource

Art Unit: 2152

coming to a destination or origin server and then decides whether to serve the request locally or redirect to another mirror site or repeater site. If the script decides that the request for a resource should be redirected to another mirror site then the URL addresses of requested resources are modified to point to the mirror or repeater site. So, the main action is concentrated on the reflector as shown on figure 1 element 108.

The architecture described in the "703" patent is entirely different. The client request coming to a destination or origin server is send to a first level domain name server for resolving the domain name to an IP number of a machine which would serve the request. The first level domain name server was modified to perform additional functions like determining where in the network a user is located (see column 9 line 33 et seq of "703" patent) so that the request is redirected to a second level domain name server wherein the second level domain name server would select an appropriate server which would server the request repeater (see "703" patent, column 10 lines 54-61.) Just from this much of information it is crystal clear that the two architectures are radically different. Further expanding on this we would see that the first level domain name server is prepended (attached in front of the domain name designation), e.g. ns1.geckil.com whrein the ns1 is the well known shorthand writing for the name server. The second level domain name server was further prepended or attached in front of the ns1.geckil.com thus creating the following address: ns2.ns1.geckil.com wherein the ns1 and ns2 are different host machines in a network. This is well explained in column 9 line 8 et seq with letters using xxxx and yy to designate first and second level domain name servers respctively. "703" patent specifically emphasises in column 9 line 33 et seq that top level or first level DNS servers are different from the regular DNS servers. This is the key to the understanding of the

Art Unit: 2152

differences between the two architectures. In “703” architecture all the control routines which will direct the client request to another low level DNS server according to the user’s location in the network is incorporated into the top level DNS server code. Alternately, in the applicant’s invention there are scripts comprising the reflector in addition to the DNS servers. So DNS servers and the reflector are different entities and thus have different level of design and complexity. As it is demonstrated hereinabove the two architectures are radically different and method claims are drafted according to the “703” patent and thus they do not operate the same way on the applicants architecture and thus they are not enabled.

Alternately, in applicant’s invention this feature of determining where the user is located in the network is done not in the DNS but by the reflector mechanism (see applicant’s specification, column 3 line 2 et seq.) This is completely different from the applicant’s invention described in the application. Thus, there was no reasonable justification to copy the claims from the “703” patent.

It would have been obvious to one of ordinary skill in the networking art at the time of the invention that the system described and claimed in “703” patent is different than the system described in the applicant’s specification as demonstrated hereinabove and copied claims do not have proper support in the applicant’s specification. Therefore, it would take undue experimentations for one of ordinary skill in the networking art at the time of the invention to figure out the details of the how the method claims would function without the modified DNSs as described in the “703” patent. Again, broader method claims would not function as claimed because the underlying DNS structure is different and thus there is no support for them as explained above and they depend on the DNSs for properly functioning.

The examiner contends that it would require undue experimentations for one of ordinary skill in the networking art to make and use the claimed invention for the reasons set forth hereinabove. Applicant is reminded that no new matter is allowed in the amendment to the specification under 35 U.S.C. 132 and 37 CFR 1.118(a).

3. Claims 49-50, 53-66 and 69 are rejected under 35 U.S.C. § 112, first paragraph, for the reasons set forth in the objection to the specification.

4. Claims 49-50, 53-54, 57-59, 62, 64-66 and 69 are rejected under 35 U.S.C. 103(a) as being unpatentable over Graber et al.

Graber et al (5,712,979) taught the invention substantially as claimed including a distributed hosting framework operative in a computer network in which users of client machines or user stations connect to a first server (col 11 line 61 et seq, e.g., 122a), the framework comprising:

a) a routine for modifying at least one embedded object URL or link of a web page to designate a repeater server instead of the origin server (col 10 lines 57-68 and col 11 line 30 et seq);

b) a second server, e.g. OLS site, distinct from the first server, e.g. 122a, for hosting some of the embedded objects of web pages (cols 10-11);

c) wherein in response to requests for the web page, generated by the client machines, the web page including the modified embedded object URL is served from the first server (col 12 line 35 et seq and col 13 line 1 et seq) and the embedded object identified by the modified embedded

Art Unit: 2152

object URL is served from a given one of the second servers (e.g. see column 12 lines 65-67, and col 13 line 9 et seq, e.g. external links appended.)

5. It would have been obvious to one of ordinary skill in the networking art at the time of the invention that the claimed invention differed from the teachings of Graber et al only by a degree, e.g. in the wording of a set of repeater servers but from a broad interpretation of the claims, even taught Grabber et al did not say that OLS servers were repeater servers, examiner interprets them as equivalent to the repeater servers because they store some of the web pages and serve them to the user. The heart of the invention, e.g., modifying embedded object URLs and inserting the modified embedded object URLs into the web page and then returning this page to the user so that these embedded objects or links can be fetched from the destinations servers where the modified embedded URL points to are all taught by Grabber et al (see for example column 13 line 9 et seq for external URL links being appended and col 14 line 2 et seq for the destination page which includes the URLs having the appended codes being passed to the user and the user executing or fetching these links by clicking on the links which is no more than a difference in scope.) Other features are all obvious variations of the well known features of the Internet art. Moreover, even though Grabber et al did not mention about using fault tolerance, e.g. replication or the like., these are well known features of the computer art for decades. Every system manager's first duty is to set up a backup system for recovery from the system disasters. Applicant's replication is an obvious variations of the well known features of the networking art, e.g. for example caching requested copies in local cache stores is taught for a long time in the Internet, e.g. Squid caching is well known. Moreover, as to the claims which recites using markup languages or tags, these features are inherent features of the www and Grabber et al

Art Unit: 2152

taught using markup languages and tags see table II. As to claims reciting redirecting from one domain to another domain, Grabber et al system exactly did that, e.g. ,see figure 1 element 122a or first server is a domain www.cm1.com and element 128 or the second server is also another domain www.ols.com and the first domain redirected requests to the second domain as explained hereinabove.

6. Claims 55,56, 60,61, and 63 are rejected under 35 U.S.C. 103(a) as being unpatentable over Graber et al in view of Bonnaure et al.

Graber et al teachings are incorporated by reference as set forth hereinabove. Serving the requested pages from servers close to the user is known in the art as network geographical data, .e.g., see Bonnaure et al (5,862,339), column 12-13, especially column 12 lines 39-68 and column 13 lines 1-34. Network geographical data comprises the network map as claimed in claim 45. It would have been obvious to one of ordinary skill in the networking art at the time of the invention to combine the teachings of Graber et al and Bonnaure et al to provide increased performance based networking system based on the user's location information.

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Art Unit: 2152

8. Claims 51, 57-59, 62, and 64 are rejected under 35 U.S.C. 102 (e) as being clearly anticipated by Grabber et al (5,812,769).

9. Grabber et al taught the invention as claimed including all the claimed limitations (see figures 1 and 5-6, and columns 5, and 11-12. Grabber et al system modified and appended the URL links into the requested page and sent the page with the appended links so that the user will select one of the embedded or appended object URL to fetch the desired object from the destination server identified by the link URL (see column 12 line 45 et seq. Claims do not recite any automatically fetching of the embedded objects pointed by the appended URL. Thus, in the Grabber et al system user selects the modified appended URL link by clicking on the link and the embedded object is resolved and the object is received from the identified destination server. This operation of the Grabber et al system reads on these claims because of the broad recitation of the claim language.

10. Applicant in the response argued that the the link URLs are different than embedded object URLs. A close look into the applicant's specification reveals that applicant never used the wording of embedded objects or embedded object URLs. This language was copied from the "703" patent. In the "703" patent, there was a good reason for using the phrase "embedded objects" or embedded object URLs because it described specifically a description for it, e.g., see col 8 line 6 et seq. It gave an example of an image tag as an example of an embedded object URL, e.g. starting with "<IMG SRC= " Alternately, applicant in the specification described receiving a resource request (very broad) and always talked about with respect to resource request, e.g. rewriting a resource request or the like. Never gave an example of how an

Art Unit: 2152

embedded object URL looks like. Therefore, Grabber's link as explained hereinabove is perfectly reads on what applicant described in the specification, i.e., resource request. Applicant is always arguing things that did not exist in the specification, e.g. like the embedded object URLs. Applicant's specification talked about rewriting resource identifiers to point to another domain but links of Grabber are also resource identifiers and they point to the other domain and they are also rewritten to point to the other domain. Regarding to the tagging, the application only mention tag or tags in another context not related to embedded objects. E.g., application only mentions tag in three occasions with respect to a reflector serving a resource to a repeater and adding "wr-" to the beginning of the HTTP tag (see page 43 line 5 et seq) or placing a special tag at the beginning of the resource when rewriting a resource from repeaters (page 45 line 20 et seq.) The tagging of the embedded objects as claimed in the claims were not taught in the applicant's specification. The fundamental problem is the copying of claim language from the "703" patent and trying to fit it into the applicant's architecture. Examiner in the various interviews advised applicant to cancel the copied claims and direct their attention to their own invention in order to advance the application. Applicant amended claim 41 which is directed towards their own invention, i.e., reciting a repeater serverselector mechanism and in the appendix applicant stating that the claimed repeater server selector mechanism is the reflector shown in figure 1. Thus examiner will indicate this claim as allowable. Since other claims are not directed towards their own architecture these claims will not be allowed.

11. Claims 41 and 45 are allowable over the cited prior art.

Art Unit: 2152

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Chow et al (6,029,175) taught rewriting of the requested URL objects to point to a Revision manager domain instead of the origin server domain (see col 10 line 5 et seq.)

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mehmet Geckil whose telephone number is (703) 305-9676. The examiner can normally be reached on Monday through Friday from 6:30 A.M. to 3:00 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor Mark Rinehart, can be reached on (703) 305-4815. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-9731.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

Any response to this action should be mailed to:

Art Unit: 2152

Commissioner of Patents and Trademarks
Washington, D.C. 20231

or faxed to:

(703) 305-9731, or (703) 746-7238 (for After final communications;

Or:

(703) 305-9731, or (703) 746-7239 (for formal communications intended
for entry)

Or:

(703) 305-9731 or (703) 746-7240 (for status inquiry or informal or draft
communications, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2021 Crystal
Drive, Arlington, VA., Fourth Floor (Receptionist).

11/30/01

MEHMET B. GECKIL
PRIMARY EXAMINER

Mehmet Geckil